UNITED STATES PATENT AND TRADEMARK OFFICE

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09/905,355	07/13/2001	Yuichiro Deguchi	SONI-6800	3808

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EXAMINER
STRANGE, AARON N

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/905,355	DEGUCHI, YUICHIRO
	Examiner	Art Unit	
	Aaron Strange	2153	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 15-51* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-11 and 15-20* is/are allowed.

6)☒ Claim(s) *21-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02042005*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   With regard to claims 1-51, the amendments to claims 1, 21, 44, and 51 are sufficient to overcome the rejection of those claims under 35 USC 112 1st Paragraph, presented in the Office action of 3/3/2005, since the limitation which is not described in the specification has been removed.

2.   Applicant's amendments to claim 1 are sufficient to overcome the rejection presented under 35 USC 103(a) in the Office actions of 10/7/2004 and 3/3/2005.

Response to Arguments

3.   Applicant's arguments with respect to claims 21-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4.   Claims 36 and 51 are objected to because of the following informalities: Appropriate correction is required.

5.   With regard to claims 36 and 51, there appears to be a typographical error "to the each one" in line 3 of claim 36 and line 7 of claim 51. The Office recommends that the claim be amended to recite "to each of the one"

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   Claims 21-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8.   With regard to claim 21, the limitation "store an event based only on one or more time stamps" is not described in the specification. The data marker device does not store "events based solely on one or more time stamps". The data marker device merely stores a timestamp corresponding to the time a button was pressed by the user. While it is disclosed that these timestamps may *correspond* to events such as a song being played on the radio, it is clear that the "events" themselves are not stored.

9.   Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10.   With regard to claim 44, the limitation "receiving identification of an event based only on one or more time stamps stored in a data marker device" is not enabled by the specification. In the present application, an event identified using at least a combination of the time stamps and the device identification code of the marker device (Page 10, Lines 25-28 of the present application). Additionally, some other information must be used to identify the event since the device is capable of identifying many different types of events such as music broadcast, television broadcasts, and even highway billboards (Page 14, Lines 19-31 of present application). In order to identify the event, the method must know at least the type of event being identified, in addition to information such as the radio station or television channel being listened to at the time the time stamp was recorded. Therefore, it is clear that the present application does not have support for "identification of an event based *only* on one or more timestamps stored in the data marker device", as recited in claim 44.

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12.   Claims 21-43 and 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13.   With regard to claim 21, the limitation "store an event" is unclear. It is unclear

how "events" may be stored. For the purpose of applying prior art this limitation has

been interpreted as storing a timestamp.

14.   Claim 21 recites the limitation "the device identification code" in line 11. There is

insufficient antecedent basis for this limitation in the claim.

15.   Claim 21 recites the limitation "the device stop time" in line 15. There is

insufficient antecedent basis for this limitation in the claim.

16.   With regard to claim 51, the limitation "storing one or more time stamps and a

device identification code as the only event identifiers stored" is unclear. The time

stamps and device identification code are not event identifiers. The time stamps merely

identify the time at which an event occurred, not the event itself, and the device

identification code clearly identifies a device rather than an event. While these items

may be used in combination when identifying an event, they are not event identifiers

alone.

17.   With further regard to claim 51, the limitation "retrieving event information in

response to time information" in line 13 is unclear. It is unclear if this time information is

the reference time information in line 5 of claim 51, "a time information" in line 8 of claim

51, or a third time information.

18.   All claims not individually rejected are rejected by virtue of their dependency from

the above claims.

Claim Rejections - 35 USC § 103

19.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

20.   Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Tarboureich et al. (US 6,650,877).

21.   With regard to claim 51, Tarboureich discloses a system for identifying a time

specific event, comprising: means for storing one or more time stamps (Col 5, Lines 48-

49) and a device identification code (Col 7, Lines 32-34) means for generating a

reference time information (Synchronization time) (Col 19, Lines 9-14); means for

receiving the one or more time stamps and the device identification code (Physical

parameters are uploaded) (Col 17, Lines 38-48), and the reference time information

(Col 18, Lines 56-66); and means for determining a time information corresponding to

the each one or more time stamps (derive activation times) (Col 19, Lines 9-14),

wherein the one or more time stamps represents content that is broadcasted (radio

broadcast) (Col 5, Lines 44-49) and means for retrieving event information in response

to time information and said device identification code stored in said portable device by

said means for storing (Col 6, Lines 1-11). However, Tarboureich fails to disclose that

the one or more time stamps and device identification code are the only event identifiers

stored.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to omit the frequency sensing unit and storing of the frequency

from Tarboureich since it has been held that omission of an element and its function is

obvious if the function of the element is not desired. Ex parte Wu, 10 USPQ 2031 (Bd.

Pat. App. & Inter. 1989). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA

1965); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and MPEP 2144. In the

present case, removing the sensing unit would also provide advantages by reducing the

cost and size of the portable device.

22.   Claims 21-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Tarboureich et al. (US 6,650,877) in view of Doyle et al.

23.   With regard to claim 21, Tarboureich discloses a system for identifying a time

specific event, comprising: a data marker device configured to store an event (time

stamp) based only on one or more time stamps (Col 5, Lines 48-49) generated

responsive to a user input operation (User activates device)(Col 5, Lines 44-49);

wherein said data marker device is configured for communicating said time stamps and

an identification code and (device identification code) (Col 7, Lines 32-34) over a data

network (Col 6, Line 64 to Col 7, Line 10); a server terminal configured for operating

over the data network to generate a reference time information (Synchronization

time)(Col 19, Lines 9-14); a user terminal configured for operating over the data network

to receive the one or more time stamps and the device identification code from the data

marker device (Col 7, Lines 28-34), and a reference time information corresponding to a

time point when the data marker device establishes connection with the user terminal

(Synchronization time)(Col 18, Lines 15-18 and Col 18, Line 56 to Col 19, Line 14).

Tarboureich further discloses determining a time information corresponding to each of

the one or more time stamps by subtracting elapsed time from the marked time stamps

from the device stop time and subtracting this amount from the reference time value

received from the server (Col 18, line 56 to Col 19, Line 46). However, Tarboureich fails

to disclose the *user terminal* receiving the reference time information from the server

terminal and calculating the time information. In the system disclosed by Tarboureich,

the server receives the time stamps from the client and determines the time information

corresponding to the time stamps itself.

Nonetheless, Doyle et al. (Doyle, hereafter) teach that the offloading of

processing from a server as a means to reduce both the load on the server and

congestion in the network near the server is well known. (Doyle, Page 6, Paragraph 1).

Since each user of the system disclosed by Tarboureich has an individual sensing unit,

the amount of calculation required for the server to determine the time information

corresponding to each time stamp for every user would get very large as the number of

users grew. With a sufficiently large number of users, the server may have become

overloaded and unusable (Doyle, Page 5, Paragraph 1). This would have required very

expensive server upgrades to keep up with demand (Doyle, Page 6, Paragraph 4) By

performing this calculation for each user on their client, which typically has sufficient

CPU cycles free to process the calculations, the load on the server would have been

drastically reduced, improving the speed and reliability of the system for the users and

reducing the cost for the service provider.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention as made to offload the calculation of the time information

corresponding to the time stamps from the server to the client of each user since this

will drastically reduce the load on the server when large numbers of users are

accessing the system. This would have improved the speed and reliability of the system

for the users and reduced the server cost for the service provider.

24.   With regard to claim 22, Tarboureich further discloses that the data marker

device includes a clock (Fig 2, 16), wherein each of the one or more time stamps

corresponds to a respective signal from the dock (device records time of activation)(Col

5, Lines 44-49).

25.   With regard to claim 23, Tarboureich further discloses that the clock is configured

to increment in a one-second interval (Clock resolution is 1 second)(Col 18, Lines 29-

31).

26.   With regard to claim 24, Tarboureich further discloses that the device

identification code includes one of a predetermined length numeric sequence, a

predetermined length letter sequence, and a predetermined length combination of

numeric and letter sequence (Unique identification or serial number) (Col 7, Lines 32-

34).

27.   With regard to claim 25, Tarboureich further discloses that the data marker

device stores time stamps based on an arbitrary running clock (Col 16, Lines 19-23).

28.   With regard to claim 26, while the system disclosed by Tarboureich shows

substantial features of the claimed invention (discussed above), including that the

reference time information includes a time information corresponding substantially to the

initial connection between the data marker device and the user terminal

(Synchronization time)(Col 18, Lines 15-18 and Col 18, Line 56 to Col 19, Line 14), it

fails to specifically disclose that this is a real time.

GMT is a well-known worldwide standard for describing a real time and date.

GMT is the same everywhere in the world, and provides a simple way to represent the

time without requiring conversion between time zones. It would have been

advantageous to use GMT to represent the time since it would allow the device to work

in any time zone without requiring conversion of the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to use GMT to represent the time in the system since it

allows the device to function across time zones without requiring any conversion.

29.   With regard to claim 27, Tarboureich further discloses that the connection

between the data marker device and the user terminal includes one of a USB

connection, a parallel connection, a serial connection, an IrDA connection and a

Bluetooth connection (Col 7, Lines 41-48).

30.   With regard to claim 28, Tarboureich further discloses that the user terminal is

configured to transmit a request signal (log-in) to the server terminal when the data

marker device establishes connection to the user terminal (Communication with server

is done via client computer) (Col 7, Lines 20-21).

31.   With regard to claim 29, as discussed regarding claim 21, it would have been

advantageous to generate and transmit the reference time information to the user

terminal in response to a request signal for the reference time received from the user

terminal, since calculating the time information corresponding to the timestamps would

have greatly reduced the load on the server.

32.   With regard to claim 30, the system disclosed by Tarboureich in view of Doyle

further discloses that time information determined by the user terminal corresponding to

the each one or more time stamps is based on the reference time information (Time is calculated based on synchronization time and timestamps)(Tarboureich, Col 19, Lines 9-14).

33.   With regard to claim 31, Tarboureich further discloses that the user terminal is further configured to transmit the number of time stamps, the device identification code, and the time information corresponding to the each one or more time stamps to the server terminal (Physical parameters are uploaded) (Col 17, Lines 38-48).

34.   With regard to claim 32, Tarboureich further discloses that the user terminal is further configured to receive a receipt acknowledgement signal from the server terminal upon termination of transmission (Feedback is received from server) (Col 17, Lines 43-47).

35.   Claim 35 is rejected for the same reasons cited for claim 28.

36.   With regard to claim 36, Tarboureich further discloses that the user terminal is further configured to transmit the number of time stamps, the device identification code, and the time information corresponding to each of the one or more time stamps to the server terminal (Physical parameters are uploaded) (Col 17, Lines 38-48).

37.   With regard to claim 37, Tarboureich further discloses that the user terminal is

further configured to receive a receipt acknowledgement signal from the server terminal

upon termination of transmission (Feedback is received from server) (Col 17, Lines 43-

47).

38.   With regard to claim 40, Tarboureich further discloses that the user terminal

includes one of a personal computer, an Internet access enabled personal digital

assistant, a Wireless Application Protocol enabled mobile telephone, and an I-mode

enabled mobile telephone (client computers) (Col 7, Lines 20-21).

39.   With regard to claim 41, Tarboureich further discloses a data network, the server

terminal and the user terminal coupled to the data network (Col 6, Line 64 to Col 7, Line

10).

40.   With regard to claim 42, Tarboureich further discloses that the server terminal

and the user terminal are coupled to the data network using one of a TCP/IP protocol

and a wireless application protocol (The Internet uses TCP/IP)(Col 6, Line 64 to Col 7,

Line 10).

41.   With regard to claim 43, Tarboureich further discloses that the user terminal

includes an output unit, wherein user terminal is further configured to launch an Internet

browser for display in the output unit (Col 7, Lines 20-24).

42.   With regard to claim 44, Tarboureich discloses a method of identifying physical

events registered as time stamps in a data marker device, comprising: receiving

identification of an event based on one or more time stamps (Col 5, Lines 48-49) stored

in a data marker device; receiving a data marker device identification code (Col 7, Lines

32-34) from the data marker device; determining a time information corresponding to

each of the one or more time stamps (derive activation times) (Col 19, Lines 9-14)

based on the reference time; and transmitting the number of time stamps, the data

marker device identification code, and the time information, corresponding to each of

the one or more time stamps (Physical parameters are uploaded) (Col 17, Lines 38-48)

to a user device account; and retrieving event information for physical events based on

data from said user device account (Col 6, Lines 30-47 and Col 7, Lines 20-48).

However, Tarboureich fails to disclose transmitting a request for reference time

information and receiving the reference time information based on the transmitting step

or that the number of timestamps, data marker identification, and time information are

the *only* items transmitted. In the system disclosed by Tarboureich, *the server* receives

the time stamps from the client and determines the time information corresponding to

the time stamps itself, and also transmits a frequency identifier.

Nonetheless, Doyle et al. (Doyle, hereafter) teach that the offloading of

processing from a server as a means to reduce both the load on the server and

congestion in the network near the server is well known. (Doyle, Page 6, Paragraph 1).

Since each user of the system disclosed by Tarboureich has an individual sensing unit,

the amount of calculation required for the server to determine the time information

corresponding to each time stamp for every user would get very large as the number of

users grew. With a sufficiently large number of users, the server may have become

overloaded and unusable (Doyle, Page 5, Paragraph 1). This would have required very

expensive server upgrades to keep up with demand (Doyle, Page 6, Paragraph 4) By

performing this calculation for each user on their client, which typically has sufficient

CPU cycles free to process the calculations, the load on the server would have been

drastically reduced, improving the speed and reliability of the system for the users and

reducing the cost for the service provider.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention as made to offload the calculation of the time information

corresponding to the time stamps from the server to the client of each user since this

will drastically reduce the load on the server when large numbers of users are

accessing the system. This would have improved the speed and reliability of the system

for the users and reduced the server cost for the service provider.

It would have also been obvious to one of ordinary skill in the art at the time the

invention was made to omit the frequency sensing unit and storing of the frequency

from Tarboureich since it has been held that omission of an element and its function is

obvious if the function of the element is not desired. Ex parte Wu, 10 USPQ 2031 (Bd.

Pat. App. & Inter. 1989). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA

1965); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975); and MPEP 2144. In the

present case, removing the sensing unit would also provide advantages by reducing the

cost and size of the portable device.

43.   With regard to claim 45, Tarboureich further. discloses including establishing a

connection using a data transfer protocol (The Internet uses TCP/IP)(Col 6, Line 64 to

Col 7, Line 10).

44.   Claims 46,47,and 50 are rejected for the same reasons cited for claims 30,32,

and 43, respectively.

45.   With regard to claim 48, Tarboureich further discloses erasing the time stamps

from the data marker device (Col 18, Lines 19-21). .

46.   With regard to claim 49, while the system disclosed by Tarboureich in view of

Doyle shows substantial features of the claimed invention (discussed above), it fails to

specifically disclose powering off the data marker device. However, the data marker

device is battery powered (Col 8, Lines 45-47), and it is well known in the art to power .

off a device as a means to conserve battery usage.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to power off the data marker device since this would

conserve battery life of the unit.

Allowable Subject Matter

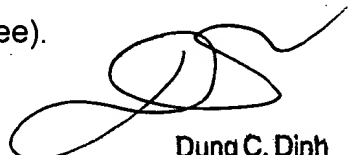47.   Claims 1-11 and 15-20 are allowed.

Conclusion

48.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

49.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aaron Strange whose telephone number is 571-272-

3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Dung C. Dinh
Primary Examiner

AS 8/10/2005